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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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09/14/2005

Patent Counsel
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EXAMINER

ZIMMER, MARC S

ART UNIT

PAPER NUMBER

1712

DATE MAILED: 09/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/759,482

Applicant(s)

MORIARTY, CHRISTOPHER J.

Examiner

Marc S. Zimmer

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-21 is/are allowed.
- 6) ☒ Claim(s) 1-7, 11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7 and 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nguyen et al., U.S. patent # 4,742,144 for the reasons outlined in the correspondence dated April 16, 2005.

The gist of Applicant's argument is that their invention is distinguished over the prior art insofar as the materials corresponding to (a) and (b) are reacted *prior to some event*, i.e. prior to their employment in the application of interest. In this connection, the following points were made:

“On the contrary, the carboxylic acid and polysiloxane of Nguyen et al. are pre-reacted to form a copolymer prior to incorporation into an aqueous solution. Likewise, Ona et al. relates to a fiber treatment agent, in which: It (Compound B; a carboxylic acid) forms a salt with the amino groups in component (A) (an organopolysiloxane), or forms an amide bond with the amino groups in component (A) according to the heating conditions, and functions to improve both the stability of the composition and the resistance to yellowing.

See Ona et al. at Col. 2, Lines 49-53.”

It should be noted however that the claims subject to rejection over the aforementioned document are composition claims. The Examiner does not dispute that, at some time preceding the utilization of these materials in their intended application, they are reacted together thereby yielding a product distinct from the precursors (a) and (b) from which it is derived. However, these claims are directed merely to a composition wherein compounds equivalent to claimed compounds (a) and (b) have been combined. Clearly, Nguyen teaches compositions equivalent to those contemplated by claims 1-13, 15, and 16 hence the rejection is proper and is hereby maintained. On the other hand, Applicant's method is distinguishable over the prior art because Ona does not mention the production of lignocellulosic materials at all and Nguyen does indeed disclose reacting (a) and (b) together before it is coated on the caul plates.

It is stated for the record that the Examiner had considered whether or not it would have been obvious to modify the process of Nguyen by simply applying (a) and (b) to the caul plates rather than applying their reaction product. MPEP 2144.04 provides several citations holding that it is obvious to alter the sequence of steps in a known process- see, for instance, *Ex parte Rubin*, 128 USPQ 440 (Bd. App. 1959) and *In re Burhans*, 154 F.2d 690, 69 USPQ 330 (CCPA 1946). An obvious motivation to do so would be to eliminate the expense and time of carrying out the reaction separate of the composite board-forming process. At issue here is whether it could be ascertained that the materials corresponding to (a) and (b) would have reacted *in situ* on the caul plates to provide the same polymer disclosed by Nguyen. In the Examiner's estimation, it is not at all clear that (a) and (b) would unquestionably form an identical product *in situ*

Art Unit: 1712

on the caul plates in view of the conditions employed for pre-reaction and those employed when pressing the lignocellulosic material.

Nguyen delineates in Example 1 a synthetic approach for reacting together materials corresponding to (a) and (b) of the claimed invention wherein they are combined in solution and heated for 4 *hours* at 95° C. A conventional pressing operation, by contrast, is performed at 190° C over a duration of 4 *minutes*. It cannot be asserted with any certainty that (a) and (b) are reacted to an appreciable extent under these conditions so Applicant's method is held as being unobvious over the prior art.

Concerning the patentability of claims 8-10 and 13-16 over Nyugen, it was, at first, tempting to reject these claims under 35 U.S.C. 103 under the rationale that it would be obvious to conduct the reaction of (a) and (b) in the same medium that would be applied to the caul plates and Nyugen does, in fact, state that their release agent may be added as an alcohol solution in column 5. However, alcohols and water would not be inert solvents under the conditions that (a) and (b) are reacted together so it would not be obvious to react (a) and (b) in an alcohol or water solution.

Allowable Subject Matter

Claims 8-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 13-21 are allowable for the reasons of record in this- and the previous Office action.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc S. Zimmer whose telephone number is 571-272-1096. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1712

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Zimmer
Marc Zimmer
AU 1712